

Attorney Docket No: 23546-07666US
Client Ref: RTS-0297
USSN: 09/920,671

REMARKS

STATUS OF THE CLAIMS

Claims 1-14 were pending in this application. Claims 3, 4, 6, 8, 10, 11, and 12 have been amended. Claims 1, 2, and 14 have been cancelled without prejudice. Following entry of the amendments, claims 3-13 will be pending and at issue.

OBJECTION TO CLAIM 3 AND AMENDMENTS TO THE CLAIMS

The Examiner objected to Claim 3 has being dependent upon a rejected base claim and stated that Claim 3 would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims and eliminating reference to non-elected subject matter.

In response, Applicant has amended claim 3 so that it is in independent form; includes all the limitations of the base and intervening claims (claims 1 and 2); and refers only to the elected subject matter (SEQ ID NO:80). In addition, Applicant has amended claims 4, 6, 8, 10, and 12 to depend on claim 3.

Finally, Applicant has amended claim 11 to recite the elected target active site, i.e., the complement of elected subject matter SEQ ID NO:80 (nucleobases 48225 to 48244 of a nucleic acid molecule encoding CoREST (SEQ ID NO:11)).

Support for these amendments to the claims are found throughout the specification as filed, e.g., in the original claims. Accordingly, the amendments present no new matter, entry is requested, and withdrawal of this objection is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 2, and 4-15 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Andres [PNAS Vol. 96:9873-9878] and Bennett et al [US 5,988,148], Baracchini et al [US 5,801,154], Weintraub [Scientific American, January 1990, pages 40-46], and GenBank AI922671 (SEQ ID NO:11).

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Applicant reiterates and incorporates the arguments made in the Response dated March 23, 2004: the combination of art cited by the Examiner does not provide a teaching or suggestion to combine the teachings, e.g., there is not teaching or suggestion to combine the target taught by Andres with the general desirability of antisense as taught by Weintraub and the antisense to specific, non-CoREST targets as taught by Bennett and Baracchini; the combination of art cited by the Examiner at best provides a generalized goal (to design antisense nucleic acids to any given target) insufficient to render obvious the claimed invention; and given that a complementary oligonucleotide may not hybridize and modulate expression of a target, one of skill in the art would have had no expectation of success when combining the elements taught by the cited combination of art.

However, without agreeing with the Examiner's position, Applicant has cancelled herein claims 1 and 2, and amended the remaining claims as appropriate to depend on amended claim 3 (which the Examiner indicated would be allowed). Withdrawal of this rejection of the claims as amended herein is therefore respectfully requested.

CONCLUSION

Withdrawal of the pending rejections and reconsideration of the claims are respectfully requested, and a notice of allowance is earnestly solicited. If the Examiner has any questions concerning this Response, the Examiner is invited to telephone Applicant's representative at (415) 875-2316.

Respectfully submitted,
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